

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants: J. Bednorz et al.

Date: December 18, 1998

Serial No. 08/303,561

Group Art Unit: 1105

Filed: September 9, 1994

Examiner: M. Kopec

For: NEW SUPERCONDUCTIVE COMPOUNDS HAVING HIGH  
TRANSITION TEMPERATURE, AND METHODS FOR THEIR  
USE AND PREPARATION

The Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**AMENDMENT AFTER FINAL REJECTION UNDER 37 CFR 1.116**

Sir:

In response to the Office Action dated June 25, 1998, please consider the following:

**REMARKS**

In the referenced final Office Action, the Examiner refers to three affidavits (of Mitzi, Tsuei and Dinger) submitted by applicants to overcome the rejection under 35 USC 112 for a lack of enablement. The Examiner's comments are at (paragraph (d)(iv) page 7, 5 lines from the bottom to page 8, 4 lines from the bottom. The Examiner states:

(d)(iv)(1) "Those affidavits do not set forth particular facts to support the conclusions that all superconductors based on the applicants' work behave in the same way and that one skilled in the art can make these superconductors without undue experimentation."

(d)(iv)(2) "Those affidavits do not overcome the non-enablement rejection."